

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Dean L. Rhoades

Serial No.: 09/802,425

Filed: March 9, 2001

For: **COMPOSITION, APPARATUS AND
METHOD FOR SKIN REJUVENATION**

Examiner: Frank I. Choi

Art Group: 1616

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant, (hereinafter "Appellant") submits, one copy of the following Reply Brief pursuant to 37 C.F.R. § 41.41 for consideration by the Board of Patent Appeals and Interferences. Please charge any additional amount due or credit any overpayment to deposit Account No. 02-2666.

ARGUMENT

In the Examiner's Answer ("Answer") to Appellant's Supplemental Amended Replacement Appeal Brief ("Brief") filed March 30, 2006, the Patent Office withdraws the rejection of claims 1-3 and 21-23 under 35 U.S.C. §112, second paragraph and the rejection of claims 1-3, 5, 7, 21 and 22 under 35 U.S.C. §103 as obvious over U.S. Patent No. 4,284,533 issued to Imamura. The Patent Office maintains the rejections of claims 1, 2, 3, 5, 7, 21, 22 and 23 under 35 U.S.C. §112, first paragraph, claims 1, 2, 3, 5, 7, 21, 22 and 23 under 35 U.S.C. §103 as being obvious over U.S. Patent No. 6,290,976 issued to Messenger ("Messenger"), claims 1, 2, 21 and 22 under U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,294,179 issued to Lee et. al. ("Lee"), claims 1-3, 21, 22 and 23 under U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,092,111 issued to Saperstein ("Saperstein") or U.S. Patent No. 4,957,747 issued to Stiefel ("Stiefel"), claims 5 and 7 under 35 U.S.C. §103(a) as obvious over U.S. Pub. No. 2002/0090385 issued to Fox et. al. ("Fox"), claims 1-3, 21 and 22 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,607,980 issued to McAtee et. al. ("McAtee"), claims 1, 2, 21 and 22 under U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,756,081 issued to Wdowik ("Wdowik"), and claims 1-3, 5, 7, 21-23 unpatentable under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,852,417 issued to McLaughlin ("McLaughlin") in view of Wdowik.

Appellant respectfully submits, for at least the reasons previously set forth and those herein, Messenger, Lee, Saperstein, Stiefel, Fox, McAtee, Wdowik and McLaughlin, alone or in combination, fail to teach or suggest each and every element of claims 1-3, 5, 7 and 21-23.

I. 35 U.S.C. §112, First Paragraph

Appellant respectfully disagrees with the Patent Office's determination that the element of "at least twenty three percent by weight a moisturizer" as recited in claim 1 is not supported by the written description. In particular, the Patent Office alleges the minimum amount of 23% moisturizer is not shown in the exemplary composition listed in the table on page 5 because the claim requires the moisturizer be 23% of the base, not the composition, as shown in the table. See Answer, page 17. The Patent Office alleges the exemplary embodiment shown on page 5

includes 35% aluminum oxide therefore the base constitutes only 65% of the example composition. Thus, the combined percentage weight of the octyl palmitate, safflower oil and propylene glycol relied upon by Appellant makes up 35.23%, not 22.9%.

Nowhere within the language of claim 1 is it recited that the base may not include abrasive particles such as aluminum oxide. Thus, although the Patent Office may separate out various components of the exemplary embodiment on page 5 of the application, claim 1 may not be limited to such an interpretation. The Patent Office improperly analogizes claims 1-3 to claims 5 and 7. Claims 1-3 are independent of claims 5 and 7 and must be read separately. Thus, the recitation of “at least thirty five percent by weight of the composition in claim 5, may not be interpreted to limit the language of claim 1 to an embodiment wherein the term “base” may not be read to include a percentage of particles as shown in the table on page 5 of the application. Finally, the Patent Office has not pointed to a portion of Appellant’s specification expressly requiring the terms “composition” and “base” as recited in the claims to be construed differently or preventing them from being used interchangeably.

Moreover, the Patent Office states that of the three compounds relied upon by Appellant, namely propylene glycol, safflower oil and octyl palmitate, only propylene glycol is specifically identified as a compound that may include a moisturizer. See Answer, page 17. The Patent Office alleges Appellant must provide evidence that safflower oil and octyl palmitate have the property of moisturizers. See Answer, page 17. Appellant respectfully submits, if the Patent Office desired such information, the Patent Office should have requested such evidence earlier in the prosecution of this case as Appellant may not now submit new evidence. In any case, it is well known that safflower oil and octyl palmitate may include moisturizing properties as described in the instant application therefore Appellant is not required to expressly categorize these components as moisturizers throughout the application. In fact, it is preferred by the Patent Office that descriptions of well known features not be included in the specification.

In regard to the Patent Office’s indication that the range of “at least thirty five percent by weight” as recited in claim 5 does not comply with the written description requirement, Appellant further disagrees. Specifically, the Patent Office states the recited range is outside the scope of paragraphs 16 and 17 of the specification and the table on page 5 further does not

support such an open ended limitation. See Answer, page 18. Paragraphs 16 and 17 recite a composition comprising “20 to 70 percent by weight of corundum” and ranges of 5 to 100 and 10 to 20 grams of corundum per ounce of cream. These portions of the specification, in combination with the table on page 5 which recites an exemplary embodiment having 35% aluminum oxide, contemplate a wide variety of abrasive particle ranges. Moreover, on page 4, paragraph [0016] of the specification, Appellant describes the many objectives achieved when the particles are included in the cream, namely, gentle microdermabrasion of the skin for resurfacing/rejuvenating the skin, reduction of fine lines and wrinkles, reduction of pore size, reduction of sun damage, age spots and skin discoloration, enhancement of new epidermal cells and decongestion of acne skin conditions. It would be understood by one of ordinary skill in the art upon review of this description that the particle content in the cream may include a variety of ranges, including a range of at least 35%, to achieve each of these results. The analysis with respect to changing numerical range limitations must take into account ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. See MPEP §2163.05. Thus, Appellant is not required to specifically recite each and every contemplated range. Appellant believes in view of the foregoing disclosure, one of ordinary skill in the art would consider the recited range of “at least 35% by weight of the composition” as being, if not expressly, inherently supported by the specification.

Lastly, in regard to the limitation of “an average particle size from 34 to 124 microns” as recited in claim 5, Appellant respectfully disagrees with the Patent Office’s characterization and analysis of Appellant’s amendments to the recited range. In particular, the Patent Office alleges Appellant’s amendments to the originally claimed range of from “34 to 556 microns” to “less than 125 microns” and “34 to 124 microns” constitutes an assertion by the Appellant that the ranges are patentably distinct from each other and therefore the originally claimed broader range does not describe the narrower range. See Answer, pages 20-21. Amending claim limitations to overcome cited prior art is entirely appropriate under the Patent Laws. Appellant does not believe such actions may be construed as an admission by Appellant that the amended range is patentably distinct from that which was originally recited for the purposes of determining compliance with the written description requirement. If such were the case, any amendment to, for example, a claimed range or genus, would render the claim noncompliant with 35 U.S.C. §112, first paragraph and raise the issue of new matter. Thus, for at least the foregoing reasons,

the Patent Office has not established that the element of “an average particle size from 34 to 124 microns” constitutes new matter or otherwise renders claim 5 noncompliant 35 U.S.C. §112, first paragraph.

Thus, for at least the foregoing reasons, the limitations of independent claims 1 and 5 and their dependent claims are in compliance with the written description requirement under 35 U.S.C. §112, first paragraph. Appellant respectfully requests the rejection of the claims on this basis be overturned.

II. The Affidavit pursuant to 37 C.F.R. § 1.131 Is Sufficient to Overcome Messenger

Appellant respectfully disagrees with the Patent Office’s assertion that Appellant’s statements with respect to the 37 CFR 1.131 affidavit in overcoming the rejection of claims 1, 5 and their dependent claims in view of Messenger contradict statements in the affidavit. In particular, in the Brief, Appellant pointed out additional components that can be classified as moisturizers. Although the affiant identified some of these ingredients, that does not mean that additional components may not be considered moisturizer components. Moreover, Appellant does not need to expressly classify or identify every moisturizer component recited in the application or contemplated by the application where the components would be understood by one of ordinary skill in the art to be moisturizers. Thus, for at least the foregoing reasons, the Patent Office has not established that claims 1, 5 and their dependent claims are *prima facie* obvious over Messenger.

Appellant further raises issue with the Patent Office’s reliance on *In re Tanczyn*, 136 USPQ 298 (CCPA 1965) for the conclusion that the affidavit pursuant to 37 C.F.R. §1.131 is insufficient to overcome the rejection of claims 1-3, 5, 7 and 21-23 under 35 U.S.C. §102 as being anticipated by Messenger because it is directed to subject matter outside the claimed invention and must show what the reference shows to antedate the reference. See Answer, page 24.

As an initial matter, Appellant has attempted to look up the above cited case in the United States Patent Quarterly, volume 136 at page 298 but could not find it. Appellant has further performed a search of the USPTO website for this case and is unable to find it. Appellant has

therefore been unable to review the above cited case to review the holding and its applicability to the instant case. Thus, Appellant is unable to determine if the case stands for the above rules which the Patent Office relies upon in objecting to the affidavit. This is the first time the Patent Office has cited to *In re Tanczyn* and raised these arguments with respect to the affidavit. Thus, Appellant has not previously had the opportunity to respond to these issues and is currently unable to respond because Appellant is unable to locate the case.

Moreover, the Patent Office has further not cited to a portion of the MPEP or C.F.R. in support of the above rules with respect to affidavits. Appellant has reviewed the portions of the MPEP discussing the use of 37 C.F.R. §1.131 affidavits to antedate a reference and is unable to discern a portion of the guidelines stating that the affidavit must show what the reference shows. Instead, MPEP §715 states that the declaration need only (1) “establish invention of the subject matter of the rejected claim prior to the effective date of the reference” and (2) “establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.”. Thus, if the Patent Office chooses to maintain the objections to the affidavit on this basis, Appellant respectfully requests the Patent Office provide Appellant with a correct citation for the *In re Tanczyn* case so that Appellant may review it and have an adequate opportunity to respond.

In any event, Appellant respectfully submits the affidavit is directed to subject matter falling within the claimed invention. In particular, claim 5 recites a particle size range of “from 34 to 124 microns” and wherein the particles are “at least thirty five percent by weight of the composition.” As pointed out by the Patent Office, Exhibit B of the affidavit shows a composition including 50% aluminum oxide and particles having a size of 120 microns. See Answer, page 24. A 120 micron particle is within the claimed range of 34 to 124 microns and 50% aluminum oxide is within the claimed range of at least 35 %. Thus, the affidavit is directed to subject matter that falls within that which is claimed.

In view of the foregoing, the affidavit 37 C.F.R. 1.131 is sufficient to antedate the Messenger. Appellant respectfully requests the rejection of the claims on this basis be overturned.

III. The Patent Office Fails to Establish that Water Is a “moisturizer”

Appellant respectfully disagrees with the Patent Office’s characterization of water as a “moisturizer.” The Patent Office alleges a “moisturizer” may “encompass a substance that adds moisture to something.” See Answer, page 26. As previously argued by Appellant, water is moisture, and is therefore not a substance that adds moisture to something. Moreover, the definition proposed by the Patent Office could include virtually any liquid. For example, a liquid such as alcohol would provide moisture (i.e., wetness) if applied to the skin and would therefore fall within this definition. Alcohol, however, would be understood by one of ordinary skill in the art as having a drying effect on the skin. Thus, although, it fits within the definition provided by the Patent Office, it would not be understood by one of ordinary skill in the art as a “moisturizer.” Similarly, water can have a drying effect on the skin and therefore would not be understood by one of ordinary skill in the art as a “moisturizer.”

The Patent Office further alleges the statement in McAtee that “the exact level of water will depend upon the form of the product and the desired moisture content” supports the Patent Office’s characterization of water as a “moisturizer.” See Answer, page 26. Appellant respectfully disagrees. As pointed out above, there are a variety of liquids which can provide moisture but this does not necessarily mean these liquids are “moisturizers” as the term is used in the instant claims. This fact is evidenced by McAtee’s separate description of the “water” component in col. 9, lines 31-39 and “humectants and moisturizers” in col. 13, lines 40-63. Nowhere within the section of McAtee describing “humectants and moisturizers” is water mentioned as being a moisturizer or component of a moisturizer. Moreover, nowhere within this section on humectants and moisturizers is “moisture content” discussed. One could reasonably expect that if “moisture content” was indicative of a “moisturizer” this property would be discussed in the section of McAtee specifically devoted to describing a “moisturizer.”

The Patent Office further alleges that if Appellant has acted as its own lexicographer and defined the term “moisturizer” as something that reduces water loss from the skin and draws moisture from the inner skin layer up to the outer skin layer as described in paragraph [0014] of the application, propylene glycol, safflower oil and octyl palmitate are not moisturizers because they do not fall within this definition and the specification doesn’t expressly describe them as

having both characteristics. See Answer, page 27. Appellant respectfully submits, Appellant has not argued a “moisturizer” must be something that reduces water loss from the skin and draws moisture from the inner skin layer.

As previously pointed out by Appellant, Appellant’s specification refers to a moisturizer as follows:

In one embodiment, the composition comprises a base that is capable of suspending the plurality of abrasive particles within the base. One particular component, that in one embodiment is included as a principal component in the base, is a moisturizer. Moisturizers are believed to reduce water loss from the skin and draw moisture from inner skin layers up into the outer skin layer. In this regard, in one embodiment, the moisturizer includes a substance that attracts moisture to the top skin layer (a humectant). Suitable humectants include glycerin, propylene glycol, alpha hydroxy acids, urea, and lactic acid. The moisturizer may also include substances that tend to reduce water loss by creating a barrier. Such substances include petrolatum, mineral oil, lanolin and silicone derivatives. See Application, page 3, paragraph [0014].

In view of the foregoing, Appellant has argued that one of ordinary skill in the art would understand that a moisturizer is able to counter dryness of the skin by attracting moisture to a top layer of the skin or reducing water loss by providing a barrier. Appellant has further argued that moisturizers include those materials that may have a property that acts as a barrier or draws moisture. Thus, Appellant has not attempted to limit the term “moisturizer” to that which both reduces water loss from the skin and draws moisture from inner layers as suggested by the Patent Office. Instead, Appellant has requested that the term “moisturizer” be defined consistent with the description of “moisturizer” expressly provided in the specification. One of ordinary skill in the art would understand propylene glycol, safflower oil and octyl palmitate as falling within the meaning of “moisturizer” as used in claim 1. In particular, one of ordinary skill in the art would understand propylene glycol, safflower oil and octyl palmitate as being commonly characterized as moisturizers and often used in cosmetics for their moisturizing properties. Since the properties of propylene glycol, safflower oil and octyl palmitate are known in the art, Appellant is not required to expressly describe them or categorize these components as “moisturizers” to now characterize them as such. In fact, it is preferred that descriptions of known features be omitted from the specification.

Thus, for at least the foregoing reasons, the Patent Office has not shown that water is a “moisturizer” as the term is used in claim 1 and its dependent claims.

IV. The References Fail to Disclose “at least about twenty three percent by weight moisturizer.”

Appellant respectfully disagrees with the Patent Office's reliance on various components in the compositions of at least Lee, Saperstein, Stiefel, McAtee and Wdowik to teach the element of “at least about twenty three percent by weight moisturizer” as recited in claim 1.

In particular, in regard to Lee, the Patent Office alleges Appellant admits a moisturizer may include a combination of ingredients and does not show that the combination excludes water. The Patent Office alleges Lee teaches a composition that contains water in combination with or without surfactants, hectorate, NaCl and xanthan gum for a total weight percent of greater than 23% of the composition. See Answer, page 30. The Patent Office concludes this composition of Lee would provide moisture to the skin and is therefore a moisturizer. See Answer, page 30. See Answer, page 30. Lee, however, does not teach that water is a “moisturizer.” Moreover, as discussed below, the mere addition of a component to the skin which provides moisture or wetness to the skin does not necessarily render it a “moisturizer” as the term is used in the instant application. Lee further does not characterize any of the components listed in composition 1 in column 4 as moisturizers or water as a component of a moisturizer. Moreover, the recitation in claim 2 of the application that “a moisturizer comprises at least one of a liquid, a gel and an emollient,” does not suggest water must be included in the moisturizer recited in claim 1. In particular, the combination of octyl palmitate, safflower oil and propylene glycol as recited in the exemplary embodiment on page 5, is a moisturizer in a liquid form in the absence of water. Thus, for at least the foregoing reasons, the Patent Office has not established Lee teaches this element of claim 1.

In regard to Saperstein, the Patent Office alleges the base disclosed in Saperstein contains sodium lauryl sulfate, sodium laurate, sodium myristate, sodium stearate, lanolin, propylene glycol, glycerine and water and even in the absence of water the rest of the ingredients add up to 39.4% of the base. See Answer, page 33. The Patent Office concludes since a moisturizer can comprise at least one emollient, and the composition of Saperstein does, the combination

provides a composition which is at least about 23% by weight a moisturizer. See Answer, page 33. One of ordinary skill in the art, however, would not understand soaps such as sodium lauryl sulfate, sodium laurate, sodium myristate and sodium stearate as being components of a moisturizer. It is well known that soaps have a tendency to dry the skin and therefore it would not be desirable to include them as components of a moisturizer. Moreover, the Patent Office has not shown, and Saperstein does not suggest, that water is considered a component of a moisturizer. Thus, the soaps and water listed in Example 4 of Saperstein may not be considered components of the moisturizer. In view of the foregoing, the composition in Saperstein may not be characterized as including “at least about 23% by weight a moisturizer” as recited in claim 1.

In regard to Stiefel, the Patent Office states water may be included in the alleged moisturizer of Stiefel to raise the percentage of moisturizer in the composition to at least about 23% by weight of the composition and that in view of the recitation of 35% aluminum oxide in the table on page 5 of the instant application and the language of claim 7 of Stiefel, the amount of moisturizer in the composition of claim 1 would actually be about 8.05% by weight of the composition. See Answer, pages 34-35. Appellant respectfully submits, the Patent Office’s interpretation of claim 1 as comprising about 8.05% moisturizer not only improperly reads limitations from Appellants specification into claim 1 but further interprets the express language of claim 1 in view of the language recited in Stiefel. As the Patent Office is no doubt aware, proper claim interpretation begins by interpreting the claims in view of the Appellant’s specification, not that of the prior art. Embodiments from the specification are not to be read into the claims. Thus, the Patent Office’s interpretation of claim 1 which limits claim 1 to about 8.05% by weight moisturizer is improper. Moreover, the Patent Office has not shown that water is a component of the moisturizer in Stiefel. Instead, Stiefel expressly lists water in Examples 1 and 2 relied upon by the Patent Office separate from the components making up the emollient. Thus, for at least the foregoing reasons, the Patent Office has not identified a portion of Stiefel teaching “at least about 23% by weight a moisturizer” as recited in claim 1.

In regard to McAtee, for at least the reasons previously discussed, McAtee does not support the Patent Office’s conclusion that water is not excluded as a component of the moisturizer. Thus, for at least the foregoing reasons, the Patent Office has not identified a portion of McAtee teaching “at least about 23% by weight a moisturizer” as recited in claim 1.

In regard to Wdowik, the Patent Office relies upon its interpretation of the “base” of claim 1 as excluding abrasive particles in reaching the conclusion that Wdowik teaches “at least about 23% by weight moisturizer” and further alleges if water is included in the moisturizer Wdowik clearly meets the limitation of claim 1. See Answer, pages 41-42. For at least the reasons previously discussed, claim 1 does not require that the weight of the base must exclude that of the abrasive particles. Moreover, the Patent Office has not shown that water is a component of a “moisturizer” as the term is used in the instant claims. Thus, for at least the foregoing reasons, the Patent Office has not identified a portion of Wdowik teaching “at least about 23% by weight a moisturizer” as recited in claim 1.

In view of the foregoing, Appellant respectfully requests the rejection of the claims in view of Lee, Saperstein, Stiefel, McAtee and Wdowik for the above reasons be overturned.

V. The References Fail to Disclose “wherein the composition may be left on the skin”

Appellant respectfully disagrees with the Patent Office’s conclusion that the element of “wherein the composition may be left on the skin” as recited in claim 21 is an intended use and inherent within the references. See Answer, page 31, 33, 35, 42 and 44.

The Patent Office alleges a recitation of intended use must result in a structural difference between the claimed invention and prior art to patentably distinguish the claimed invention from the prior art. See Answer, page 31. As previously noted by Appellant, Appellant does not believe the above limitation is a recitation of intended use. In any event, assuming for the sake of argument it is an intended use, Appellant respectfully submits it does result in a structural difference from that of the references. In particular, for a composition to be left on the skin as recited, it may have the proper balance of a moisturizer and abrasive particle sizes, e.g., 23% moisturizer and particle sizes from 50 microns to 556 microns and, in some cases, 34 microns to 124 microns. If not, leaving the composition on the skin may overly dry the skin or result in absorption of unwanted particles into pores of the skin which may clog the pores. For at least the reasons discussed previously in the Brief, each of the references do not teach the claimed combination and further do not contemplate such concerns and are therefore structurally different from the composition of claim 21 and its dependent claims. Accordingly, the element of

“wherein the composition may be left on the skin after application” should be given patentable weight.

Moreover, Appellant respectfully disagrees with the Patent Office’s reading of limitations from paragraph [0032] into claim 21. See Answer, page 32. Claim 21 recites “wherein the composition may be left on the skin after application” and therefore should be broadly construed to mean that the composition is left on the skin after application. It may not be limited to the exemplary embodiment of paragraph [0032] in which unabsorbed portions of the composition are optionally rinsed off.

Moreover, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” See MPEP §2112(IV). Until the Patent Office has met this burden, the burden is not on Appellant to show that the subject matter disclosed in the reference is not capable of performing the missing element. Appellant respectfully submits the Patent Office has not yet met its burden.

In particular, in regard to Lee, the Patent Office admits that Lee discloses rinsing the skin after washing the skin with the product. See Answer, page 32. In the Final Office Action dated 12/10/2004 the Patent Office alleged Lee is intended to be applied to the skin and therefore inherently taught the elements of claim 21 and concluded on this basis that “Applicant still has the burden of showing that the composition of Lee is toxic if left on the skin.” See Final Office Action, page 9. As previously pointed out by the Appellant, Appellant is not required to show that the composition of Lee is toxic if left on the skin. Moreover, in concluding this element is inherent in Lee because Lee teaches a composition applied to the skin, the Patent Office has not met its initial burden of establishing that this element is inherent in Lee.

In regard to Saperstein, the Patent Office alleges the elements of claim 21 are inherent in Saperstein because Saperstein discloses that the composition can be left on the skin for ten counts. See Answer, page 33. Appellant respectfully submits the portion of Saperstein pointed to by the Patent Office, namely col. 8, lines 53-57, teaches an application process in which the

composition is applied in a rotary motion for 10 counts and then removed from the skin. This ten count period is not “after application” as is recited in claim 21. Moreover, as pointed out by Appellant in the Brief, Saperstein teaches that the objective of the treatment is to keep the resulting sebum washed off the skin. See Saperstein, col. 9, lines 59-60. In addition, Saperstein cautions that using the composition according to this routine may result in irritation and scaling and suggest the user discontinue use of the composition for a day or so. See Saperstein, col. 8, lines 61-67. Accordingly, Saperstein strongly implies the composition may cause damage to the skin if left on. Thus in view of the foregoing disclosure in Saperstein and the failure of the Patent Office to show that the composition in Saperstein is necessarily “left on the skin after application,” the Patent Office has not shown that this element is inherent in Saperstein.

In regard to Stiefel, the Patent Office merely presumes this element is inherent in Stiefel and requires Appellant to rebut this presumption. See Answer, page 36. For at least the reasons previously discussed in the Brief and those herein, Stiefel does not disclose the recited composition therefore it may not be presumed this element is necessarily found within Stiefel. Thus, because the Patent Office has failed to show that the composition in Stiefel is necessarily “left on the skin after application,” the Patent Office has not shown that this element is inherent in Stiefel.

In regard to Wdowik, the Patent Office merely presumes this element is inherent in Wdowik and requires Appellant to rebut this presumption. See Answer, pages 42 and 44. For at least the reasons previously discussed in the Brief and those herein, Wdowik does not disclose the recited composition therefore it may not be presumed this element is necessarily found within Wdowik. Thus, because the Patent Office has failed to show that the composition in Wdowik is necessarily “left on the skin after application,” the Patent Office has not shown that this element is inherent in Wdowik.

In view of the foregoing, Appellant respectfully requests the rejection of claim 21 on this basis be overturned.

VI. The Claims of Fox Do not Teach the “same invention” As Claims 5 and 7.

Appellant respectfully disagrees with the Patent Office’s determination that the claims of Fox are directed to the “same invention” as that of claim 5 and dependent claim 7 of the instant application and therefore the 37 CFR 1.131 affidavit may not be used to antedate the reference.

Claim 5 recites the element of “wherein the plurality of particles of corundum are at least thirty five percent by weight of the composition.”

The Patent Office states this element is taught by claim 6 of Fox which recites the coated crystal to carrier ratio is 1 to 2. See Answer, page 36. The Patent Office alleges the coated crystal to carrier ratio of 1 to 2 means 50% and therefore is within the range of “at least thirty five percent.” See Answer, page 37.

Appellant respectfully submits, a recitation of a ratio of crystal to carrier of 1 to 2 does not teach particles comprising “at least thirty five percent by weight of the composition.” In particular, the Patent Office emphasizes that claim 5 recites particles comprising at least thirty five percent by weight of the composition. Following along with the Patent Office’s distinction between a base and a composition, a crystal to carrier ratio of 1 to 2 may not be characterized as teaching the weight percentage of the crystals with respect to the composition, but instead the ratio of crystals to base. Moreover, a ratio of 1 to 2 does not teach 50% as alleged by the Patent Office. See Answer, page 37. Instead, the ratio of crystals to base would be only 33%. For example, assuming for the sake of argument the total weight of the composition is made up of crystal and base, if the amount of crystals is 50 units, the amount of base would be 100 units and the total composition would be 150 units. Accordingly, the crystals would only make up 50/150 units or 33% of the composition. It is further contemplated that the percentage of crystals in the composition would be even lower if the composition is made up of more than just crystal and base. Thus, Fox does not teach a composition wherein at least 35% of the composition is particles of corundum. Accordingly, since the claims of Fox may not be relied upon to teach at least this element of claim 5, Fox and the instant application do not claim the “same invention.”

In view of the foregoing, the declaration 37 C.F.R. 1.131 is sufficient to antedate the references. Appellant respectfully requests the rejection of the claims on this basis be overturned.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: December 4, 2006

By: 

William Thomas Babbitt, Reg. No. 39,591

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
Telephone (310) 207-3800
Facsimile (310) 820-5988

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically
via EFS Web to the United States Patent and Trademark Office on
December 4, 2006.


Suzanne Johnston